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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,469	06/25/2003	Philip M. Sadler	55138-CON(71331)	3506
21874	7590	02/11/2005	EXAMINER	
EDWARDS & ANGELL, LLP			NGUYEN, THONG Q	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	
			2872	

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,469

Applicant(s)

SADLER, PHILIP M.

Examiner

Thong Q Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004 and 04 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) .
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Dec. 6, 2004 has been entered.

Response to Amendment

2. The present Office action is made in response to the amendment filed on Nov. 4, 2004.

It is noted that in the mentioned amendment, applicant has filed a substitute specification with its marked-up copy and a statement that the substitute specification does not contain any new matter.

It is also noted that applicant has made amendments to claims 1 and 21-23 and add a new claim, i.e., claim 24, into the application. A review of the device claimed in the newly-added claim 24 has resulted that the device of new claim has the same scope as that recited in the original claims 1-16 and 21-23, and thus, all pending claims 1-16 and 21-24 are examined in this Office action.

Claims 17-20 were canceled by the applicant in the amendment of June 25, 2003.

Specification

3. The lengthy specification which is amended by the amendment has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

4. The disclosure is objected to because of the following informalities: Page 1, line 4, -, now U.S. Patent No. 6,614,593—should be added after “March 24, 2001”.
Appropriate correction is required.

Claim Objections

5. Claims 21 and 24 are objected to because of the following informalities.
Appropriate correction is required.

a) In claim 21: on line 5, “an a telescope” should be changed to —a telescope—;

b) In claim 24: on line 1, “fold ed” should be changed to —folded—.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-16 and 21-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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a) Claim 1 is rejected under 35 USC 112, first paragraph because the specification as original filed does not provide support for the feature thereof "the at least two light...common optical axis" as recited in the newly-added materials to the claim, last two lines.

Applicant should note that the device as described in the specification comprises light folding devices in the form of mirrors or prisms (26, 28 and 30). While three mirrors or prisms are not arranged on the common optical axis; however, each set of two folding devices are indeed arranged on a common optical axis. For instance, the mirrors or prisms 26 and 28 are arranged in the common optical axis defined between the mirrors or prism 26 and 28; and the mirrors or prisms 28 and 30 are arranged in the common optical axis defined between the mirrors or prism 28 and 30.

b) Claim 21 is rejected under 35 USC 112, first paragraph for the same reason as set forth in element a) above.

c) The remaining claims are dependent upon the rejected base claims and thus inherit the deficiencies thereof.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 23 is indefinite because it is unclear about the bound and metes defined by the recitation thereof "other straight reference object... of light" (lines 2-3).

Applicant should note that such a rejection to the claim is made to claim 14 as original filed. While applicant has amended claim 14 to overcome the rejection; however, the claim 23 is drafted in an identical to the original claim 14 and applicant has not made any amendment to the claim 23 to make the claim comply with the rule.

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-2, 4-6, 11-14 and 21-24, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over James (U.S. Patent No. 3,603,664, submitted by applicant) in view of Braymer (U.S. Patent No. 2,753,760) (all of record).

James discloses a telescope system having a telescope rotatably mounted on a mounting system. The telescope system as described in columns 3-4 and shown in figures 1-2 comprises the following features: First, a telescope assembly having optics including at least two light folding elements (24, 25, 26), an eyepiece or camera (28) disposed near the focus (F) of the system, a projecting surface located around the position of the eyepiece or camera; Second, a telescope frame (14) of a spherical configuration for supporting the optics of the telescope assembly; and Third, a mounting system (12) having a curved supporting surface for rotatably supporting the telescope frame wherein the

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center of curvature of the curved surface © does not change during the process of rotation the telescope frame. It is noted that the mounting system (12) has a diameter which is matched or larger than the diameter of the telescope frame (14). It is also noted that each of the light folding elements is in the form of a mirror, and the range of the rotating angle cover a range of 0 degree to 90 degrees as claimed in present claim 5. The use of bearing elements (30) and ring (40) will stabilize the telescope frame at any specified elevation. Regarding to the arrangement of light folding elements as recited in the newly-added materials to claims 1 and 21, it is understood that the newly-added feature which is read in the light of the specification is directed to the arrangement of two light folding devices arranged on the common optical axis and three light folding devices are not arranged in the common optical axis. In the light of the description in the present specification and in the board interpreter of the feature thereof "the at least two... optic axis" recited on last two lines of each claims 1 and 21, then, the mentioned feature is disclosed in the device of James because he discloses that two folding devices 24 and 25 arranged on the common optical axis.

There are two things missing from the telescope system provided by James are as follow: First, he does not explicitly state the use of an objective lens in the telescope assembly, and Second, he does not disclose the use of a pointing system with the telescope. However, a telescope system having a lens located in the object side of the telescope which also comprises a pointing system is known to one skilled in the art as can be seen in the telescope system provided by

Braymer. In his telescope system described in columns 2-3 and shown in figures 1-2, Braymer discloses the use of a lens element (7) at the object side of the telescope system and a pointing system having objective lens (19') which is in combination with a prism (18) provides a visual guide having an optical axis parallel to the axis of the light incident onto the first mirror (5,6).

Regarding to the feature that the at least two light folding devices and the second lens are structured to project an image on the interior surface of the telescope frame where it is observable from the outside of the telescope frame as recited in the last three lines of new claim 24, such a feature is readable from the combined product provided by James and Braymer. In other words, while James does not clearly show that the image formed by the light folding devices and lens is projected on an interior surface of the frame; however, such a feature is disclosed in the device of Braymer. The support for that conclusion is shown in the system of Braymer having lens and folding devices which are in combination projected an image on an interior surface of the frame which image is observed by an eyepiece system (13). See figure 1 and column 2.

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the telescope system having a telescope frame supporting optics and a mounting system as provided by James by using a telescope assembly having a lens in the object side as suggested by Braymer for the purpose of correcting the image aberrations and a pointing system integrally

to the telescope frame supporting the optics as suggested by Braymer for the purpose of providing a means for finding the object before an observation.

Allowable Subject Matter

12. The allowability of claims 3, 7-10 and 15-16 is withdrawn because the claims are dependent upon the base claim 1 which is subjected to a rejection under 35 USC 112, first paragraph as set forth in this Office action.

Response to Arguments

13. Regarding to the rejection of claims 1-2, 4-6, 11 and 13-14, now applied to claims 1-2, 4-6, 11-14 and 21-24, applicant's arguments filed on 11/4/2004 have been fully considered but they are not persuasive for the following reasons.

A) Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

B) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

C) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant

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relies (i.e., all light folding devices of the applied art are disposed/arranged on the common optic axis...) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

D) In response to applicant's argument that the combined art does not disclose that the light folding devices are not arranged in a common optic axis and the structured to project an image inside the interior surface of the frame. The Examiner respectfully disagrees with the applicant and respectfully invites the applicant to review the combined product provided by James and Braymer. In particular, regarding to the arrangement of light folding elements as recited in the newly-added materials to claims 1 and 21, it is understood that the newly-added feature which is read in the light of the specification is directed to the arrangement of two light folding devices arranged on the common optical axis and three light folding devices are not arranged in the common optical axis. In the light of the description in the present specification and in the board interpreter of the feature thereof "the at least two...optic axis" recited on last two lines of each claims 1 and 21, then, the mentioned feature is disclosed in the device of James because he discloses that two folding devices 24 and 25 arranged on the common optical axis.

Regarding to the feature that the at least two light folding devices and the second lens are structured to project an image on the interior surface of the telescope

frame where it is observable from the outside of the telescope frame as recited in the last three lines of new claim 24, such a feature is readable from the combined product provided by James and Braymer. In other words, while James does not clearly show that the image formed by the light folding devices and lens is projected on an interior surface of the frame; however, such a feature is disclosed in the device of Braymer. The support for that conclusion is shown in the system of Braymer having lens and folding devices which are in combination projected an image on an interior surface of the frame which image is observed by an eyepiece system (13). See figure 1 and column 2.

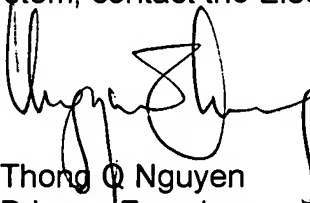
Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen
Primary Examiner
Art Unit 2872
